

**REMARKS**

Justification for the amendments is as follows. With respect to the claims, claims 9, 13, 14, 15, 42, 49, 51, 58, 60, 84, 85, 86, 87, 88, 91, 95, 96, and 97 are canceled above without prejudice to their renewal. Applicants specifically reserve the right to prosecute the subject matter of these claims in continuing applications. Claims 78 and 82 are amended above to correct typographical errors. Claim 83 is amended above to no longer depend from and to include all limitations of claim 8, as suggested by the Examiner. Claims 89 and 98 are amended above to be independent claims.

No new matter is added by any of the above amendments.

**I. Claim Status**

Claims 1-74 were originally filed, and were subject to restriction. In response to the Restriction Requirement dated 09 July 2001, Applicants elected with traverse the claims of Group I, claims 1-21, 30, and 42-74. In the Amendment dated 16 August 2002, claims 1, 22-29, 31-41, 52, and 63 were canceled without prejudice to their renewal and claim 75 was added. In the Amendment dated 24 June 2003, claims 16-20, 46, 53, and 74 were canceled without prejudice to their renewal and claims 76-98 were added. Claims 9, 13, 14, 15, 42, 49, 51, 58, 60, 84, 85, 86, 87, 88, 91, 95, 96, and 97 are canceled without prejudice to their renewal in the present Amendment. Therefore, claims 2-6, 8, 12, 21, 30, 43-45, 47, 48, 50, 54-57, 59, 61, 62, 64-68, 70-73, 75-83, 89, 90, 92-94, and 98 are pending. In the Office Action dated 16 September 2003, the Examiner indicated that claims 4-6, 30, 43-45, 47, 48, 50, 54-57, 59, 64-68, 70-73, 76-82, 90, and 92-94 are allowable.

**II. Rejection of claims 14, 15, 84, 87, 88, 96, and 97 under the doctrine of obviousness-type double patenting**

The Examiner rejected claims 14, 15, 84, 87, 88, 96, and 97 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 29 of U.S. Patent No. 6,413,742. Claims 14, 15, 84, 87, 88, 96, and 97 are canceled above in order to expedite

prosecution of the present case. Withdrawal of the rejection of claims 14, 15, 84, 87, 88, 96, and 97 as unpatentable over claim 29 of U.S. Patent No. 6,413,742 is thus respectfully requested.

III. Rejection of claims 14, 15, 84, 87, 88, 96, and 97 under the doctrine of obviousness-type double patenting

The Examiner rejected claims 14, 15, 84, 87, 88, 96, and 97 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 31 of U.S. Patent No. 6,428,978. In order to expedite prosecution of the present application, these claims are canceled herein, and withdrawal of the rejection of claims 14, 15, 84, 87, 88, 96, and 97 as unpatentable over claim 31 of U.S. Patent No. 6,428,978 is thus respectfully requested.

IV. Rejection of claims 2, 3, 8, 9, 12-14, 21, 61, 75, 84, 87, 88, and 95-98 under the doctrine of obviousness-type double patenting

The Examiner provisionally rejected claims 2, 3, 8, 9, 12-14, 21, 61, 75, 84, 87, 88, and 95-98 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 12-18, and 47-48 of copending U.S. Patent Application No. 10/232,175 (US 2003/0064074). Applicants note that this is a provisional rejection as each of these applications is yet pending, and no terminal disclaimer need be filed at the present time.

V. Rejection of claims 88, 89, 97, and 98 under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 88, 89, 97, and 98 under 35 U.S.C. 112, second paragraph. Claims 88 and 97 are canceled herein, and the rejection is thus moot as to these claims. With respect to claims 89 and 98, the Examiner stated that the term "altered collagen construct" renders these claims indefinite. (Office Action, page 6, subsection 10.) Applicants submit that the term "altered collagen construct" as recited in claims 89 and 98, amended above to be independent claims, would be understood by a person of skill in the art in view of the specification. The specification states "[a]n altered collagen construct is a polynucleotide comprising a sequence that is altered, through deletions, additions, substitutions, or other changes, from a naturally occurring collagen gene." (See the specification at page 12, lines 11-13.) The specification also discloses that "altered collagen constructs" include "constructs containing a polynucleotide encoding at least one collagenous domain, but not encoding naturally occurring collagen." (See

the specification at page 23, lines 21-23.) Applicants submit that the meaning of the term "altered collagen construct", as recited in the instant claims, would be apparent to one of ordinary skill in the art, and that amended claims 89 and 98 are thus clear and definite.

As claims 88 and 97 are canceled above, and amended claims 89 and 98 are free of the rejection, withdrawal of the rejection of claims 88, 89, 97, and 98 under 35 U.S.C. 112, second paragraph, is respectfully requested.

VI. Rejection of claims 13-15, 42, 49, 51, 58, 60, 84-87, 91, 95, and 96 under 35 U.S.C. 102(b)

The Examiner rejected claims 13-15, 42, 49, 51, 58, 60, 84-87, 91, 95, and 96 under 35 U.S.C. 102(b) as being anticipated by Tardy et al. (U.S. Patent No. 5,618,551). These claims are canceled above in order to expedite prosecution of the present case, and the rejection is therefore moot as to these claims. Withdrawal of the rejection of claims 13-15, 42, 49, 51, 58, 60, 84-87, 91, 95, and 96 under 35 U.S.C. 102(b) as being anticipated by Tardy et al. is thus respectfully requested.

VII. Rejection of claims 42, 49, 51, 60-62, 84, 87, and 96 under 35 U.S.C. 102(e)

Claims 42, 49, 51, 60-62, 84, 87, and 96 were rejected under 35 U.S.C. 102(e) as being anticipated by Wironen et al. (U.S. 2002/0098222 A1). Claims 42, 49, 51, 60, 84, 87, and 96 are canceled above in order to expedite prosecution of the present case, and the rejection is thus moot as to these claims. With respect to claims 61 and 62, Applicants believe the Examiner included these claims in the rejection through inadvertent error. In particular, Wironen et al. describes a "bone paste useful in the orthopedic arts". (Abstract) Claims 61 and 62, in contrast, recite a "pharmaceutical stabilizer" and a "microcarrier", respectively. Wironen et al. thus fails to anticipate claims 61 and 62. As claims 42, 49, 51, 60, 84, 87, and 96 are canceled above, and claims 61 and 62 are not anticipated by Wironen et al., withdrawal of the rejection of these claims under 35 U.S.C. 102(e) as being anticipated by this reference is respectfully requested.

VIII. Rejection of claims 9, 14, 15, 84, 87, 88, 96, and 97 under 35 U.S.C. 102(e)

The Examiner rejected claims 9, 14, 15, 84, 87, 88, 96, and 97 under 35 U.S.C. 102(e) as being anticipated by Olsen et al. (U.S. Patent No. 6,428,978). As claims 9, 14, 15, 84, 87, 88, 96, and 97 are canceled above in order to expedite prosecution of the present application, the rejection is thus moot as to these claims, and withdrawal of the rejection is therefore respectfully requested.

IX. Objection to claim 83

The Examiner objected to claim 83 for being dependent upon a rejected base claim. The Examiner stated this claim would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. Accordingly, claim 83 is amended above as requested by the Examiner, and Applicants submit this claim is thus allowable.

CONCLUSION

The Examiner's indication that claims 4-6, 30, 43-45, 47, 48, 50, 54-57, 59, 64-68, 70-73, 76-82, 90, 92-94, and 83 as amended, are allowable is much appreciated. Applicants believe that the present application is now in condition for allowance.

Please call Applicants' Attorney, Leanne C. Price, directly at 650-866-7254 with any questions regarding this communication.

Respectfully submitted,

Date: 15 March 2004

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